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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,178	10/16/2001	Gene Stellan	2334 DIV	5414

7590 09/08/2004

United States Surgical, a division of
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EXAMINER

DESANTO, MATTHEW F

ART UNIT PAPER NUMBER

3763

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,178

Applicant(s)

STELLON ET AL.

Examiner

Matthew F DeSanto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2-10, 14-19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Danks et al. (USPN 5868773).

Danks et al. discloses a cannula (13), an obturator assembly (12), an obturator housing (distal end of Figure 3B), a penetrating tip (81), an elongated shield (15), a guard (51), a latch mechanism (33), a blocking surface (25), a mating surface (28), a release member with a button surface (22) and a camming surface (29) and a flat knife blade. (Figures 2A, 3A-3C, Figures 6A-6D and entire reference)

3. Claims 2-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwemberger et al. (5904699).

Schwemberger et al. discloses a cannula (40), an obturator assembly, a housing (51), a penetrating tip (61), an elongated shield, a guard (56), a latch mechanism including a release member (52), and a latch operatively associated with the release member. (Figures 1, 3D, 11, 14, Column 10, line 53 - Column 11, line 35 [with regards to the method claims and the movement of the guard with respect to applied force] and entire reference)

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4. Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmes et al. (USPN 4,931,042).

Holmes et al. discloses a trocar assembly with a cannula assembly with a release member (26b) with a camming surface that imparts lateral movement of a blocking surface on a latch (40), which permits movement of a shield (26) and a penetrating tip (24). (Figures 1, 2, Column 4, lines 46-52, and entire reference)

5. Claims 2-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (USPN 5,387,197).

Smith et al. discloses a trocar assembly with a cannula assembly with a release member (270,230) with a camming surface that imparts lateral movement of a blocking surface on a latch (250), which permits movement of a shield and a penetrating tip. (Figures 1, 4, 4A, 5, Column 11, lines 8-33 and entire reference)

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 2-10, and 14-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-9 of U.S. Patent No. 6,319,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because the above mentioned patent are substantially similar to the claims in the instant application because they both claim the same structural limitations such as a cannula, an obturator assembly, a housing, a penetrating tip, an elongated shield, a guard, a latch mechanism, a blocking surface, a mating surface, and a flat knife blade.

Allowable Subject Matter

8. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed 5/19/04 have been fully considered and are persuasive with regards to Holmes claims 2-10, 14-21 and Danks claims 11-13, but are not persuasive with regards to Danks claims 2-10, 14-19, 21, Smith et al. and Schwemberger et al.

The examiner would first like to state that the applicant is arguing limitations such as structure and function that is not in the claims. Therefore, making most of the arguments erroneous. With regards to Danks, this is seen with regards to actuating the

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trigger, as well as discussing the trigger. The examiner supplied the reference numbers and the applicant has mistaken what are the latch member and the release member.

With regards to Schwemberger et al. and Smith the applicant discusses arming and actuating the obturator, as well as the precocked the level. The examiner understands that the applicant's invention is not precocked, but this is not claimed. The applicant added functionally limitations that state the release member has to be capable of moving in a proximally direction (as well as impart vertical movement) and when this happens the camming surface on the release member will move "substantially laterally" and the shield will move in an axial direction. The term substantially broadens the term laterally and therefore if the element moves in a circular direction and during that time any structure moves laterally that would read on the claim.

The examiner would also like to refer the applicant to the MPEP, wherein the MPEP states that an apparatus claim must be structurally different than the prior art in order to receive a patent, Section 2114.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto
Art Unit 3763
September 1, 2004



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SUPERVISORY PATENT EXAMINER
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